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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,409	12/30/2003	Johanna Jacoba Maria Meulenberg	01-1793-4-C4	4880
75413	7590	08/19/2011	EXAMINER	
Michael P. Morris			HILL, MYRON G	
Boehringer Ingelheim USA Corporation				
900 Ridgebury Road			ART UNIT	
Ridgefield, CT 06877-0368			PAPER NUMBER	
			1648	
			NOTIFICATION DATE	
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			08/19/2011	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO.e-Office.rdg@boehringer-ingelheim.com

Office Action Summary	Application No. 10/750,409	Applicant(s) MEULENBERG ET AL.
	Examiner MYRON HILL	Art Unit 1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,22,24 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,22,24 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
|---|--|

DETAILED ACTION

This action is in response to the papers filed 5/26/11.

This action is on claims 21, 22, 24, and 32-37.

Rejections Withdrawn

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 33 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant deleted the rejected term and the rejection is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 21 and 24 were rejected under 35 U.S.C. 102(b) as anticipated by Wensvoort *et al.* (WO 92/21375) as evidenced by Meulenberg *et al.* (J Virology 1998 Vol. 72, pages 380-387, from IDS, copy in parent application 09874626).

After further consideration of the rejection and response, the rejection is withdrawn.

Rejections Maintained

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wensvoort *et al.* (WO 92/21375), Moormann *et al.* (Journal of Virology 1996, Vol 70, pages 763-770).

Applicant argues there is nothing in Wensvoort *et al.* to teach or suggest or motivate one to make a full length infectious clone that includes SEQ ID# 18. Applicant argues that the prior art must be enabling and that claim 4 is not enabled. Applicant also argues that until the present invention, it was not known that SEQ ID# 18 was important.

Applicant's arguments have been fully considered and not found persuasive.

Wensvoort *et al.* in claim 4 describes a vector corresponding to the isolate deposit CNCMI-1102. This vector corresponds to the infectious agent, not the sequence

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disclosed in Wensvoort *et al.* and the virus itself comprises SEQ ID# 18 on the 5 prime terminus as indicated above.

As discussed above and previously, the prior art makes it clear that full length clones are needed and one of ordinary skill in the art would have been motivated to make full length clones. Moormann *et al.*, as discussed previously, teach the need to make full length clones.

The fact that Wensvoort *et al.* does not teach SEQ ID# 18 does not teach away from a full length clone. One of ordinary skill in the art at the time of invention would have been motivated to make a full length clone of isolate deposit CNCMI-1102 because of the teaching of Wensvoort *et al.* disclose it (in claim 4).

The use of inherent features not disclosed in the prior art but present as shown by the examiner do not teach away from the claimed invention and applicant's use of unrealized properties does not add to the patentability of claims.

Thus, the claims are unpatentable over Wensvoort *et al.* and Moormann *et al.*

Claims 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wensvoort *et al.* (WO 92/21375), and Moormann *et al.* (Journal of Virology 1996, Vol 70, pages 763-770) as applied to claims 21, 22, and 24, further in view of Drew *et al.*

Applicant argues this rejection in combination with the preceding rejection.

Applicant's arguments have been fully considered and not found persuasive.

Applicant's arguments were responded to above and there appear to be no specific arguments related to Drew *et al.*

The rejection is maintained.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MYRON HILL whose telephone number is (571)272-0901. The examiner can normally be reached on Tues, Thurs, and flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zachariah Lucas can be reached on 571-272-0905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary E. Mosher/
Primary Examiner, Art Unit 1648

/M. G. H./
Examiner, Art Unit 1648